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09/661,163	09/13/2000	Steven A. Weiss	30083-pa	7517

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EXAMINER	
NGUYEN, KIM T	
ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 09/661,163	Applicant(s) WEISS, STEVEN A.
	Examiner Kim Nguyen	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The amendment filed on December 9, 2002 (paper No. 15) has been received and considered. By this amendment, claims 1-7 and 9-25 are pending, claim 8 has been canceled in the amendment filed on January 2, 2002 (paper No. 7), therefore, claim 8 is not considered in this office action.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 11, 14 and 20 are not properly supported in the specification.

Claim Objections

2. Claims 1, 3, 19-20, and 22 are objected to because of the following informalities:

a) In claim 1, line 2; claim 20, line 2; and claim 22, line 2; the claimed "***the*** gaming device" should be corrected to "***a*** gaming device".

b) In claim 3, line 2; and claim 22, line 3; the claimed "***the*** player" should be corrected to "***a*** player".

c) In claim 19, line 8, the claimed "at least ***on***" should be corrected to "at least ***one***".

d) In claim 1, line 22; and claim 19, line 15; the claimed "encoded moveable media" should be corrected to "***an*** encoded moveable media".

e) In claim 20, line 28, the claimed "chance means" should be corrected to "***the*** chance means".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-21, and 24-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) In claim 1, lines 3-4, the claimed limitation "produce a plurality of outcomes ... ***concurrent games***" are not disclosed in the specification.

b) In claim 1, lines 6-7, the claimed limitation "displaying ... ***concurrent games***" are not disclosed in the specification.

c) In claim 1, lines 8-9, the claimed limitation "***comparing*** ... ***concurrent games***" are not disclosed in the specification.

d) In claim 1, lines 14-15, the claimed limitation "if any of said ... ***concurrent games***" are not disclosed in the specification.

Although the specification page 12, lines 3-4, mentions allowing the player**s** to concurrently engage in a competition game, the specification does not disclose how the game can be concurrently played, and the specification does not teach providing outcome**s** to be compared with concurrent game**s** and comparing the concurrent games with an ultimate/intermediate winning outcome.

e) Claim 19, lines 4-9 and 11, is similarly rejected as discussed in claim 1, section 112, first paragraph, above.

f) In claim 20, lines 3-9, refer to discussion in claim 1, section 112, first paragraph, above.

g) In claim 24, lines 6-9, the claimed limitation "means for transferring ... a plurality of said first gaming event" are not disclosed in the specification. The specification does not disclose how the outcome is transferred from one game to another, further, the first and second game events are ambiguous. What are the first and second gaming events?

h) In claim 25, lines 6-7, the claimed limitation "means for playing ... first gaming events" are not disclosed in the specification. Further, the first and second gaming events are ambiguous. What are the first and second gaming events?

i) Claims 2-7, 9-18, and 21 are rejected as being dependent on the rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claim 1, lines 6 and 21; and claim 20, line 31; the claimed limitation "outcomes" is ambiguous, because it is not clear if the outcomes imply the displayed number in box 22 (Fig. 3), or in an element 20 (Fig. 3) in the matrix 21.

b) In claim 1, lines 8-9, the claimed limitation "comparing each of said plurality of outcomes for each of said plurality of concurrent games to said ultimate winning outcomes" is ambiguous and not correspond with the specification, because the specification teaches comparing the covered matrix (not outcome) with the ultimate winning outcome.

c) In claim 1, lines 11-14, 16-17 and 19-20, the claimed limitation "***outcomes*** matches said ultimate winning outcome" is ambiguous as discussed in section 4b) above.

d) In claim 19, lines 3-4, the claimed limitation "random output means appearing on said display" is not properly supported in the specification. Fig. 3 does not show the "random output means" on the display. What is the "random output means"?

e) In claim 19, lines 6-7, the claimed limitation "comparing each ... winning outcomes" is referred to discussion in claim 1, lines 8-9, in section 4b) above.

f) In claim 20, lines 11-12, the claimed limitation "***outcomes*** matches said ultimate winning outcome" is referred to discussion in section 4b) above.

g) Claims 2-7, 9-18, and 21 are rejected as being dependent on the rejected base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Falciglia (US. Patent No. 5,935,002)

As per claim 24, Falciglia discloses a display (Fig. 1), a processor 132 (Fig. 5) including a random output means 7b (Fig. 1), means for transferring a subset of outcomes to a second gaming event and awarding the gaming event (col. 6, lines 1-10). Falciglia does not explicitly teach the claimed continuance means. However, Falciglia teaches allowing the player to play a game that includes several concurrent events (col. 6, lines 1-10). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a continuance means to facilitate transferring outcomes from one game event to another game event.

6. Claims 1-7, 9-10, 12-13, 15-19, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falciglia (US. Patent No. 5,935,002) in view of Nakamura (US. Patent No. 6,468,162).

a. As per claim 1-4, Falciglia discloses a method for gaming. The method comprises the steps of making a wager (col. 4, lines 57-58); evoking chance means to produce outcomes to be used in a plurality of concurrent games (col. 6, lines 25-27) and displaying the outcomes (col. 4, lines 52-55 and col. 5, lines 25-40); comparing each outcome to an ultimate winning outcome (col. 2, lines 22-27); determining whether the plurality of outcomes match an intermediate winning outcome and awarding the intermediate winning (col. 6, lines 1-6); and continuing to evoke chance means until the ultimate winning outcome is produced or the outcomes are exhausted (col. 5, lines 21-24 and col. 6, lines 7-10). Falciglia does not explicitly disclose triggering a subsequent event if the plurality of outcomes match the ultimate winning outcome. However, Falciglia discloses triggering a subsequent event for a highest winning (col. 7, lines 14-17), further, triggering a subsequent bonus game for an ultimate winning (highest winning) would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the player who wins the highest winning to play a well known bonus game in order to allow the player to obtain more winning chances.

Falciglia does not disclose saving the current set of outcomes on encoded movable media. However, Nakamura discloses saving information of a suspended game (col. 8, lines 36-43). It

would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the saving method of Nakamura to the game method of Falciglia in order to allow a user to resume playing a suspended game.

b. As per claim 5, Falciglia discloses awarding complimentary items (col. 6, lines 64-66).

c. As per claim 6-7, 10 and 13, Falciglia discloses a subsequent gaming event and awarding credits (col. 7, lines 14-35).

d. As per claim 9, 12, 15, and 21, Falciglia does not disclose simulating a racing event or keno gaming event. However, activating a racing event or a keno event as subsequent game events would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a racing event or keno gaming event in the subsequent games of Falciglia in order to allow the player to play a racing or keno bonus game.

e. As per claim 16-17, Falciglia discloses a game which involves a single player (Fig. 1) or a plurality of players (Fig. 4 and col. 1, lines 49-52).

f. As per claim 18, Falciglia discloses a three dimensional RxC matrix (Fig. 1).

g. As per claim 19, refer to discussion in claim 1 above.

h. As per claim 25, refer to discussion in claims 24 and 1 above.

7. Claims 11, 14, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falciglia (US. Patent No. 5,935,002) in view of Nakamura (US. Patent No. 6,468,162) and Seelig et al (US. Patent No. 6,450,884).

a. As per claim 11 and 14, Falciglia and Nakamura do not disclose a subsequent gaming event as claimed. However, Seelig discloses a subsequent gaming event that allows the player to select a subset of outcomes, generating outcomes, and comparing the generated outcomes with the selected outcomes, and awarding the player (col. 13, lines 23-28).

b. As per claim 20, 22, and 23, refer to discussion in claims 1 and 11 above.

Response to Arguments

8. Applicant's arguments filed December 9, 2002 have been fully considered but they are not persuasive.

a) The restriction on claims 24-25 have been withdrawn because claims 24-25 are not supported in the specification and the meaning of claims 24-25 are not clear at this stage (refer to 112 first paragraph, section above) to determine the unity of the invention, therefore, the restriction has been withdrawn.

b) In response to applicant's argument in page 11, second paragraph, refer to explanation in claim 1, section 35 USC 103 rejection above.

c) In response to applicant's argument in page 11, last paragraph, and page 12, lines 1-4, that there is no suggestion to combine the references, the examiner recognizes that obviousness

can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the game machine of Falciglia includes a microprocessor 132 (Fig. 5) and a memory device 138 (Fig. 5), implementing a disk drive to be interfaced with the microprocessor to store in the external disk drive would have been obvious to a person of ordinary skill in the art.

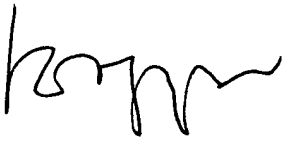
d) In response to applicant's argument in page 12, first paragraph, and page 15, first paragraph, applicant's argument is moot in new ground of rejections.

e) In response to applicant's argument in page 12, last paragraph, and pages 13-14, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine references is found in the knowledge generally available to one ordinary skill in the art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 7:3OAM to 5:3OPM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



Kim Nguyen
Patent Examiner
February 19, 2003